



WIPO Arbitration and Mediation Center

ADMINISTRATIVE PANEL DECISION

Bundesrepublik Deutschland (Federal Republic of Germany) v. RJG Engineering, Inc.

Case No. D2004-0676

1. The Parties

Complainant is Bundesrepublik Deutschland (Federal Republic of Germany), Berlin, Germany, represented by attorney Friedrich Kurz, Germany.

Respondent is RJG Engineering, Inc., Lincoln, Nebraska, United States of America.

2. The Domain Name and Registrar

The disputed domain name <federalrepublicofgermany.biz> is registered with eNom, of Redmond, WA, United States of America.

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on August 25, 2004. On August 26, 2004, the Center transmitted by email to eNom a request for registrar verification in connection with the domain name at issue.

In its response, on August 27, 2004, eNom confirmed that, in accordance with the Policy, the domain name at issue had been placed under a locked status.

The eNom Whois database indicates RJG Engineering as Registrant for the domain name at issue and that "Lauck Gary" is the administrative, billing, and technical contact.

The Center verified that the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the "Policy"), the Rules for Uniform Domain Name Dispute Resolution Policy (the "Rules"), and the WIPO Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the "Supplemental Rules") were satisfied.

In accordance with the Rules, paragraphs 2(a) and 4(a), the Center formally notified the Respondent of the Complaint, and the proceedings commenced on August 31, 2004. In accordance with the Rules, paragraph 5(a), the due date for

Response was September 20, 2004.

The Complaint was sent to RJG Engineering, Inc. by post/courier, facsimile, and e-mail. The Notification of Complaint sent by post/courier was returned, but the fax containing that notification was received. The transmission to Respondent's e-mail was also received.

The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on September 21, 2004.

The Center appointed Henry Olsson as the Sole Panelist in this matter on September 27, 2004. The Panel finds that it was properly constituted. The Panel has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the Center to ensure compliance with the Rules, paragraph 7.

4. Factual Background

The internationally used and authorized translation in English of "Bundesrepublik Deutschland" is "Federal Republic of Germany".

The "Presse- und Informationsamt der Bundesregierung" is in English "Press and Information Office of the Federal Government" and is abbreviated as "Bundespresseamt" (Federal Press Office). It is the federal authority for government information in Germany including the Chancellor of Germany and the Federal Chancellery. For instance, it is responsible for the websites of the German Federal Government ("www.federalrepublicofgermany.de", "www.bundesregierung.de", and "www.government.de") and of the German Federal Chancellery ("www.bundestkanzleramt.de", "www.kanzleramt.biz", and "www.kanzleramt.de").

In accordance with Paragraph 3(b)(xiii) of the Policy, Complainant agrees to submit, only with respect to any challenge that may be made by Respondent to a decision by the Administrative Panel to transfer or cancel the domain name that is the subject of the Complaint, to the jurisdiction of the courts of Redmond, WA, United States.

5. Parties' Contentions

A. Complainant

Complainant first states that it is the holder of the domain names which are mentioned under section 4 above. According to Complainant, it has not registered its trademarks/names but has common law service trademark rights to "Federal Republic of Germany". Complainant furthermore contends that "Federal Republic of Germany" is well known in Germany and also worldwide to designate the German State. That State renders a variety of services, such as providing public information under this name, for instance on the Internet at "http://federalrepublicofgermany.de". The identical websites "www.federalrepublicofgermany.de" and "www.deutschland.de" are, according to Complainant, the official government web sites of the German Federal Republic. Complainant contends that those websites offer links to important German information sites under headings such as Education, Health, Culture, Media, Sports, etc. and also about the tasks and the work of the German Government.

On the basis of these contentions Complainant alleges that "federalrepublicofgermany" is used in the course of trade, like the names of other German Ministries (which were the subject of WIPO cases D2001-1401, D2002-0110 and D2002-0599). Therefore, the term at issue meets the standards of Article 4, Second Paragraph, of the German Trademark Law, according to which service mark rights and trademark rights are established not only by registration but also by active use in public. Complainant furthermore contends that a trademark does not have to be registered to fall within the scope of the Policy.

Complainant discusses the issue whether geographical names may be the subject of trademark rights for the purposes of domain name disputes. Complainant suggests that, in contrast with domain names denominating geographical regions (such as New Zealand in WIPO Case D2002-0754), the domain name at issue predominantly is a sign of the political and economical entity of the Federal Republic of Germany; the disputed domain name is not "Germany" as a geographical name but "federalrepublicofgermany" which is the name of that political and economic entity.

Complainant furthermore contends that the disputed domain name is obviously identical to the service mark.

According to Complainant, Respondent has no rights or legitimate interest in using the disputed domain name and

does not conduct any *bona fide* business. By using the domain name, Respondent gained illegal advantages of the public knowledge of "Federal Republic of Germany". This and other domain names used by Respondent are or have been directed to the website of an American Nazi Group which describes itself as the organization for the reestablishment of the NSDAP and which explicitly aims at abolishing the democratic system in the Federal Republic of Germany.

The website to which the domain name is redirecting, also contains additional material which, according to Complainant, is not only criminal but also deeply offensive to the Jewish community in Germany and all over the world.

Complainant adds that the activities of Respondent in trying to take illicit advantage of the reputation of German government authorities are intentional: Complainant refers to a notice to visitors of redirected domain names: "Important Notice! If you reached this web-site via an alternative url please immediately record our real 'url:http://www.nazi-lauck.nsdapao.com!'" Alternative url addresses sometimes suddenly cease to function".

According to Complainant, Respondent has registered and uses the disputed domain name in bad faith. Complainant contends that Respondent registered the domain name with the intent to mislead Internet users who try to obtain information about the the Federal Republic of Germany to a Nazi website which is dedicated to the "battle against the constitution of the Republic of Germany". Complainant adds that Respondent's intention is not only to mislead Internet traffic but also to discredit the Federal Republic by showing and distributing nazi propaganda material under a domain name which is identical to the Complainant's service mark; the official translation from German to English of "Federal Republic of Germany".

On the basis of these contentions, Complainant requests the Administrative Panel to issue a decision that the domain name <federalrepublicofgermany.biz> be transferred to Complainant.

B. Respondent

The Respondent did not reply to the Complainant's contentions.

6. Discussion and Findings

Paragraph 15 of Rules states that the Panel shall decide a Complaint on the basis of the statements made and document submitted and in accordance with the Policy, the Rules and any principles of law that it may deem applicable.

In the case of a default by a party, Paragraph 14 of the Rules states that if a party, in the absence of exceptional circumstances, does not comply with a provision of, or a requirement under, the Rules, the Panel shall draw such inferences therefrom as it considers appropriate.

In this case, Respondent has been sent the Complaint but has not submitted any response and has consequently not, despite the opportunity given, contested any of the contentions by Complainant. In this situation, the Panel will have to operate and consider the case on the basis of the factual circumstances contained in the Complaint and documents available to support these contentions.

From the information available follows that the domain name at issue is registered by eNom and that the domain name is registered with RJG Engineering, Inc, Lincoln, Nebraska, United States, and also that Administrative Contact is Lauck, Gerhard, with the same address as RJG Engineering.

The Panel is satisfied that the Policy is applicable to the domain name registration at issue and that Respondent therefore is obliged to submit to a mandatory administrative proceeding as the one which is now initiated.

The Panel is also satisfied that the Complaint has been duly communicated to Respondent and that there is, from this point of view, no obstacle to considering the Complaint.

Paragraph 4a. of the Policy directs that Complainant must prove each of the following:

- that the domain name registered by Respondent is identical or confusingly similar to a trademark or service mark in which Complainant has rights,
- that Respondent has no rights or legitimate interests in the domain name, and

- that the domain name has been registered and is being used in bad faith.

A. Identical or Confusingly Similar

Complainant has, according to Paragraph 4a.(i) of the Policy, to prove that the domain name is identical or confusingly similar to a trademark or a service mark in which Complainant has rights.

The domain name at issue is <federalrepublicofgermany.biz>.

The first issue which the Panel has to consider is whether "federalrepublicofgermany" would enjoy protection under German trademark law.

In this respect the Panel notes that Article 4, Paragraph 2 of the German Trademark Act prescribes that trademark protection shall accrue: "through the use of a sign in the course of trade insofar as the sign has acquired a secondary meaning as a trademark within the affected trade circles."

In its considerations concerning this issue the Panel notes that obviously the name Federal Republic of Germany is well known in Germany as indicating the "Bundesrepublik Deutschland" and that the name has a particularly distinctive character and thus is a sign to which trademark protection may apply. Such protection presupposes that the sign at issue has acquired a secondary meaning as a trademark in the course of trade. In this respect Complainant contends that the Federal Republic renders a variety of services, *inter alia* public information, under this name on, for instance, the Internet and that websites related to the Federal Government offer comprehensive information in several areas related to the activities of the Government.

In considering these aspects, the Panel comes to the conclusion that those activities are a form of trade of services directed to the German people and others who seek information about, *inter alia*, various government services. The Panel finds that the circumstances present in the case indicate that "federalrepublicofgermany" has acquired a secondary meaning as a service mark.

The Panel consequently finds it to be established, for the purposes of this dispute, that "federalrepublicofgermany" enjoys trademark protection under Article 4, Paragraph 2, of the German Trademark Act.

As established in earlier WIPO decisions, a trademark or a service mark does not need to be registered in order for the Policy to apply.

The domain name at issue contains the service mark "federalrepublicofgermany" with the addition "biz". This is an insignificant distinction, which does not remove the likelihood of confusion.

The Panel thus concludes that there exists a confusing similarity between the domain name at issue and Complainant's protected service mark.

B. Rights or Legitimate Interests

In this respect, Complainant has, according to Paragraph 4a.(ii) of the Policy to prove that Respondent has no rights or legitimate interests in the domain name at issue.

To prove its contentions in this respect, Complainant has mentioned a number of circumstances, among them that Respondent does not conduct any *bona fide* business but uses the domain name to direct visitors to Respondent's own website and thus takes illicit advantage of the reputation of German public authorities.

Respondent has not, despite the opportunity given, contested or responded to Complainant's allegations in this respect.

The Panel notes that no arguments have been advanced by Respondent to the effect that the domain name has been used for diffusion of information for the purpose of "free speech". The Panel has looked at the web site in question, and notes that there seems to be some commercial activity at the web page, and, as discussed below, the Respondent seems to have registered the domain name in the hope of attracting Internet users to its site by taking advantage of confusion with Complainant's mark.

On the basis of Complainant's contentions, supported by documentation, and in the absence of any Response from Respondent, the Panel is satisfied that Respondent has no rights or legitimate interests in the domain name at issue.

The Panel therefore concludes that the second element of the Policy is met.

C. Registered and Used in Bad Faith

In this respect, Complainant has, according to Paragraph 4a.(iii) of the Policy, to prove that the domain name has been registered and is being used in bad faith. Paragraph 4b sets out the circumstances that in particular, but without limitation, shall be considered as evidence of registration and use of a domain name in bad faith.

To support its contentions in this respect, Complainant has invoked a number of circumstances, which have been referred to above, in particular that the domain name at issue is being used to direct visitors to Respondent's own website containing, *inter alia*, Nazi material. Respondent is clearly aware of the rights of the Complainant because Respondent has put a notice on its own website to visitors that "alternative url addresses sometimes suddenly cease to function" and that they therefore should immediately download Respondent's own website address. Respondent registered a domain name that is identical to the name and service mark of Complainant, in the hope of attracting Internet users to its site by taking advantage of confusion with Complainant's mark, and then linked it to a site containing material that is targeted at the Complainant and highly offensive to Complainant. This, coupled with the Respondent's awareness of Complainant and Complainant's rights, amounts to bad faith. Given that Respondent sells books and other periodicals at the site, its registration and commercial use fall within circumstance outlined in paragraph 4(b)(iv) of the Policy.

Respondent has not, despite the opportunity given, responded to the allegations by Complainant.

On the basis of the circumstances present in the case the Panel is satisfied that Complainant has sufficiently proved its allegations about registration and use of the domain name at issue in bad faith.

Conclusion

The Administrative Panel concludes that it has been established that the domain name at issue is confusingly similar to the service mark in which Complainant has rights, that Respondent has no rights or legitimate interests in the domain name and that that domain name has been registered and is being used in bad faith.

7. Decision

For all the foregoing reasons, in accordance with Paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the domain name <federalrepublicofgermany.biz> be transferred to Complainant.

Henry Olsson
Sole Panelist

Dated: October 1, 2004